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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,372	10/16/2003	Teiyu Goto	SCEI 3.3-017 CONT CONT	9281
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LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			BROCKETTI, JULIE K	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/687,372	Applicant(s) GOTO ET AL.	
	Examiner Julie K Brockett	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43 and 44 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yokoi et al., U.S. Patent No. 5,820,462. Yokoi discloses an operating device for a game machine and a game machine. A main unit is used for reading a game program (See Yokoi col. 1 lines 9-15). The operating device, which is interconnected with the main unit, includes a main body and first and second grips projecting in a first direction from the main body at spaced positions (See

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Yokoi Fig. 1, items 14L & 14R). A first operating unit is mounted to the main body adjacent one of the spaced positions. The first operating unit has an input element operable to generate a signal (See Yokoi Fig. 1, item 15L). A second operating unit is mounted to the main body adjacent another one of the spaced positions. The second operating unit has an input element operable to generate a signal (See Yokoi Fig. 1, item 15R). A third and fourth operating unit are projecting in a first direction from the main body between the first and second grips. Each of the third and fourth operating units have an input element operable to generate a signal (See Yokoi Fig. 1, items 19B, 19A, 18A-18C). For example, one can consider items 18A-19B to be projecting in the same direction, i.e. down, as the grips in which case Yokoi et al. anticipates this limitation. However, if one does not consider Yokoi et al. to be projecting items 18A-19B in the same direction as the grips since they are angled this limitation would be obvious over Yokoi under 103(a). At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to position the third and fourth operating units so as to be projecting in the first direction from the main body between the first and second grips because Applicant has not disclosed that positioning the operating units so as to be projecting in the first direction provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the third and fourth operating units

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positioned in any other arrangement on the main body because the ability for a player to utilize the operating units is not affected by their location on the main body [claims 43-44].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16, 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoi et al., U.S. Patent No. 5,820,462 in view of Nishiumi et al., U.S. Patent No. 5,897,437.

Yokoi discloses an operating device for a game machine. The device comprises a main body and first and second grips protruding at spaced portions from the main body (See Yokoi Fig. 1). A first operating unit is mounted to the main body adjacent one of the spaced positions. The first operating unit has an input element operable to generate a signal (See Yokoi Fig. 1, item 15L). A second operating unit is mounted to the main body adjacent another one of the spaced positions, the second operating unit has an input element operable to generate a signal (See Yokoi Fig. 1, item 15R). Third and fourth operating units are mounted to the main body so as to be

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positioned between and adjacent the first and second grips (See Yokoi Fig. 1, items 18A-19B). The third operating unit is positioned adjacent to the first operating unit and one of the spaced positions and has an input element operable to generate a signal (See Yokoi Fig. 1, item 19B). The fourth operating unit is positioned adjacent to the second operating unit and another one of the spaced positions and has an input element operable to generate a signal (See Yokoi Fig. 1, item 18C). Both the third and fourth operating units project from the main body between the first and second grips. The third operating unit projects from the first operating unit to a position between the first and second grips. The fourth operating unit projects from the second operating unit to a position between the first and second grips (See Yokoi Fig. 1, items 19B & 18C) [claims 1, 4, 7, 10, 13, 16, 19-24]. The main body has front and rear sides. The first and second grips protrude from the rear side of the main body. A fifth and sixth operating units are arranged on the front side of the main body. Each of the fifth and sixth operating units has an input element operable to generate a signal (See Yokoi Fig. 2, items 16R & 16L) [claims 3, 6, 9, 12, 15, 18]. Yokoi et al. further discloses a game machine with a main unit for reading a game program (See Yokoi col. 1 lines 9-15) [claims 20-24]. Yokoi lacks in disclosing the fourth operating unit having a rotation member and an input element operable to generate a signal in response to an operation of the rotation member.

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Nishiumi teaches of a controller, which has an operating unit in the form of a rotation member, which has an input element operable to generate a signal in response to an operation of the rotation member (See Nishiumi Fig. 7, item 45; col. 5 lines 34-57) [claims 1, 4, 7, 10, 13, 16, 19-24]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the rotation member of Nishiumi as an operating unit in the controller of Yokoi. By using a rotation member operating unit, a player may designate a direction within a range of 360 degrees thereby giving the player more flexibility in character movement during game play. Therefore, a player is capable of many more moves and directions making the game more exciting to the player. The Examiner notes that the rotation member of Nishiumi would replace either item 15L or 15R of Yokoi, which are used to designate direction. While these have been considered to be operating units one and two with reference to Applicant's invention. The Examiner notes that it would also have been obvious to one of ordinary skill in the art at the time the invention was made to switch the positioning of any of the operating units of Yokoi. The various positions of the operating units does not effect the controllers overall operation as long as a player can utilize all of the operating units.

Claims 2, 5, 8, 11, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoi in view of Nishiumi as applied to claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16, 18-24 above, and further in view of Chen, U.S. Patent No. 5,742,278. Yokoi lacks in disclosing a vibration-imparting

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unit. While Nishiumi does disclose a vibration-imparting unit, it is not specifically in the grips of the controller. Chen teaches of a joystick with a vibration-imparting unit arranged in at least one of the first and second grips (See Chen Fig. 13, col. 3 lines 18-27; col. 14 lines 44-49). For example, the vibrations are applied directly to the place where the player's hand is on the joystick [claims 2, 5, 8, 11, 14 and 17]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place a vibrating unit into the grip portions of Yokoi. Through the creation of force effects in a controller, a player gets feedback as they play the game; thereby providing a more realistic felt to the game, which makes the game more enjoyable.

Claims 25-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoi in view of Chen, U.S. Patent No. 5,742,278.

Yokoi discloses an operating device for a game machine. The device comprises a main body and first and second grips protruding at spaced portions from the main body (See Yokoi Fig. 1). A first operating unit is mounted to the main body adjacent one of the spaced positions. The first operating unit has an input element operable to generate a signal (See Yokoi Fig. 1, item 15L). A second operating unit is mounted to the main body adjacent another one of the spaced positions, the second operating unit has an input element operable to generate a signal (See Yokoi Fig. 1, item 15R). Third and fourth operating units are mounted to the main body so as to be positioned between and adjacent the first and second grips (See Yokoi Fig. 1, items 18A-19B). The third operating

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unit is positioned adjacent to the first operating unit and one of the spaced positions and has an input element operable to generate a signal (See Yokoi Fig. 1, item 19B). The fourth operating unit is positioned adjacent to the second operating unit and another one of the spaced positions and has an input element operable to generate a signal (See Yokoi Fig. 1, item 18C). Both the third and fourth operating units project from the main body between the first and second grips. The third operating unit projects from the first operating unit to a position between the first and second grips. The fourth operating unit projects from the second operating unit to a position between the first and second grips (See Yokoi Fig. 1, items 19B & 18C) [claims 25, 27, 29, 31, 33, 35, 37-42]. The main body has front and rear sides. The first and second grips protrude from the rear side of the main body. A fifth and sixth operating units are arranged on the front side of the main body. Each of the fifth and sixth operating units has an input element operable to generate a signal (See Yokoi Fig. 2, items 16R & 16L) [claims 26, 28, 30, 32, 34, 36]. Yokoi et al. further discloses a game machine with a main unit for reading a game program (See Yokoi col. 1 lines 9-15) [claims 37-42]. Yokoi lacks in disclosing a vibration-imparting unit.

Chen teaches of a joystick with a vibration-imparting unit arranged in at least one of the first and second grips (See Chen Fig. 13, col. 3 lines 18-27; col. 14 lines 44-49). For example, the vibrations are applied directly to the place where the player's hand is on the joystick [claims 25, 27, 29, 31, 33, 35, 37-

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42]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place a vibrating unit into the grip portions of Yokoi. Through the creation of force effects in a controller, a player gets feedback as they play the game; thereby providing a more realistic felt to the game, which makes the game more enjoyable.

Claims 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoi, U.S. Patent No. 5,820,462. Yokoi discloses an operating device for a game machine and a game machine. A main unit is used for reading a game program (See Yokoi col. 1 lines 9-15). The operating device, which is interconnected with the main unit, includes a main body and first and second grips projecting at spaced positions from the main body (See Yokoi Fig. 1, items 14L & 14R). A first operating unit is mounted to the main body adjacent one of the spaced positions. The first operating unit has an input element operable to generate a signal (See Yokoi Fig. 1, item 15L). A second operating unit is mounted to the main body adjacent another one of the spaced positions. The second operating unit has an input element operable to generate a signal (See Yokoi Fig. 1, item 15R). A third and fourth operating unit are mounted to the main body between the first and second grips. Each of the third and fourth operating units have an input element operable to generate a signal. The third and fourth operating units are mounted to the main body so as to be positioned within the W-shape when viewed from the direction normal to the plane. (See Yokoi Fig. 1, items 19B, 19A, 18A-18C).

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Yokoi's first and second grips and main body collectively define a generally W-shape in a plane when viewed in a direction normal to the plane. Therefore, Yokoi does not disclose a U-shape. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to position the grips and main body to form a U-shape because Applicant has not disclosed that the U-shape, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the a W-shape, since a player can still easily grasp the controller and utilize the operating units [claims 45 & 46].

Response to Amendment

It has been noted that claims 1, 4, 7, 10, 11, 13, 16, 19-24 have been amended. New claims 25-46 have been added.

Response to Arguments

Applicant's arguments filed June 24, 2004 have been fully considered but they are not persuasive.

The Examiner agrees that a rotation member gives different types of inputs than those discussed in Yokoi. However, Nishiumi does disclose a rotation member as discussed by Applicant and the combination of Yokoi and Nishiumi is obvious and one would be motivated to use the rotation member of

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Nishiumi in the invention of Yokoi so that a player could produce various inputs up to 360 degrees. Applicant argues that while Nishiumi does disclose a joystick 45 capable of analog input, the joystick is not in the positions required by the claims and since buttons 18A-C of Yokoi perform different operations it would not be obvious to replace the buttons with the joystick of Nishiumi. The Examiner acknowledges the fact that Yokoi has the directional input device in a different position than Applicant. However, it is simply a matter of design choice where to put the various operating units on the controller. It would have been obvious to place items 15L or 15R in the places where items 18A-19B are in Yokoi. Applicant has not disclosed that the positioning of the various operating units provides an advantage, is used for a particular purpose or solves a stated problem. Therefore, one of ordinary skill in the art, would have expected Applicant's invention to perform equally well with the various operating units in other arrangements because the ability of the operating units to send data is not affected by their location on the main body of the controller.

Applicant argues that while Nishiumi does disclose a vibration-imparting element, the element is contained in a controller pack and not in the grips of the controller. While the Examiner agrees with the Applicant that the vibration-imparting element is not in the grips of the controller, the Examiner does not say that it would not be obvious to implement the vibration unit in the grips. Nevertheless, the Examiner has now used the reference Chen to teach

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this limitation; therefore the arguments with respect to the vibration-imparting unit of Nishiumi are moot.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the vibrations in one grip can be different from the vibrations in the other grip) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that newly submitted claims 43 and 44 are patentably distinct from Yokoi and Nishiumi in that none of the operating units project in the same direction as the grips. The Examiner disagrees and refers Applicant to the rejection above.

Applicant argues that newly submitted claims 45 and 46 are patentably distinct from Yokoi and Nishiumi in that they don't define a U-shape. The Examiner agrees that Yokoi and Nishiumi do not define a U-shape, but Yokoi discloses a W-shape and a U-shape would be obvious for the reasons set forth in the rejection above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Julie K Brockett
Examiner
Art Unit 3713